

REMARKS

Claim 1 is amended with subject matter from canceled claims. Claims 3, 5 and 7 are canceled without prejudice or disclaimer, herein. Therefore, no new matter is added. Claims 1, 2 and 4 are pending.

In view of the above amendments and following remarks, reconsideration of this application is respectfully requested.

I. Rejections Under 35 U.S.C. §112

The Office Action rejects claims 1-7 under 35 U.S.C. §112, first paragraph. Specifically, the Office Action rejects claim 1's "the counter electrode contacting the light absorbing dye" subject matter. Applicants have amended claim 1 to remove the rejected subject matter. Accordingly, Applicants respectfully request the withdrawal of this rejection.

II. Rejection under 35 U.S.C. §102

The Office Action rejects claims 1, 2, and 5 under 35 U.S.C. §102(b) over Park et al. (K.W. Park, K.S. Ahn, J.H. Choi, Y.C. Nah, Y.M. Kim, "Pt-WO_x electrode structure for thin-film fuel cells," Applied Physics Letters 81, (2002) 907-909, hereinafter as "Park"). This rejection is respectfully traversed.

The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants' independent claim 1 recites, a method for fabricating a counter electrode for a dye-sensitized solar cell, the method comprising: co-sputtering platinum and a metal oxide as target materials onto a substrate; and forming a counter electrode including nanocrystalline

platinum and an amorphous metal oxide on the substrate, wherein the counter electrode has a non-layered structure, wherein the metal oxide comprises a metal having an open structure and wherein the metal oxide is selected from oxides of tantalum and silicon.

Since the subject matter of claim 7 was not rejected under 102(b), and claim 1 now has been amended with the subject matter of claim 7, Park does not anticipate all the features recited in Applicants' independent claim 1. Accordingly, the rejection under 102(b) for claim 1 has been overcome. In view of the above, Applicants respectfully request the withdrawal of this rejection.

III. Rejections under 35 U.S.C. §103

The Office Action rejects claims 1 and 7 under 35 U.S.C. §103(a) over Pruneanu et al. (S. Pruneanu, G. Mihailescu, E. Indrea, "Nanoporous Al₂O₃ membranes filled by platinum," Semiconductor Conference 2000, CAS 2000 Proceedings, International 2, (2000) 475-478, herein after as "Pruneanu") in view of Park. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim features. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Since the subject matter of claim 5 was not rejected under 103(a), and claim 1 now has been amended with the subject matter of claim 5, Pruneanu does not disclose or suggest all the features of Applicants' independent claim 1. Therefore, Park and Pruneanu, individually or in combination, do not disclose or suggest all the features of Applicants' claimed subject matter.

In view of the above, Applicants respectfully request the withdrawal of this rejection.

The Office Action rejects claims 3 and 4 under 35 U.S.C. §103(a) over Park in view of Vink et al. (T.J. Vink, W. Walrave, J.L.C. Daams, P.C. Baarslag, J.E.A.M. van den Meerakker, "On the homogeneity of sputter-deposited ITO films Part I. Stress and microstructure," Thin

Solid Films 266 (1995) pp. 145-151, hereinafter as "Vink"). This rejection is respectfully traversed.

Claim 4 depends from claim 1. For at least the reasons stated above, claim 1 is allowable over Park. And since Vink is addressed to the subject matter of claim 4, Park and Vink, do not anticipate or suggest all the features recited in Applicants' independent claim 1, now having the subject matter of claim 5 and 7. Accordingly, claim 4 should be allowable for depending from allowable claim 1. Therefore, Applicants respectfully requests the withdrawal of this rejection.

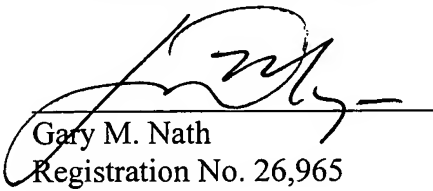
CONCLUSION

In light of the foregoing, Applicants submit that the application is in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner call the undersigned.

Respectfully submitted,
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